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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,709	07/16/2002	Zwi H Kalman	Kalman-1	4596

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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50404

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Commissioner for Patents

The reply filed on 28 February 2005 is not fully responsive to the prior Office Action because: it fails to provide claims that would encompass the elected species. See the Office communication signed 1/27/05 (mailed 1/28/05). Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

Applicant's arguments have been considered. First, it is noted that the arguments discuss "elected claims". Species are elected or non-elected. Inventions are elected or not elected. Claims are then drawn to the species or invention.

Applicant argues that the previous Examiner required Applicant to rewrite the claims in independent form. This is not completely accurate. See the objection for what was actually said. More importantly, it appears to be completely irrelevant – Applicant has not pointed out any relevance nor is Examiner aware of any relevance. Whereas the Office regrets anything which might have implied that Applicant's present response would have been sufficient. Such was not intended. Regardless, Applicant's arguments are based on Applicant erroneously inference – not any promise by the Office. Furthermore, the Office's communication (of 1/28/05) does not prohibit a claim directed to the unelected specie – rather it is the removal/elimination of all claims that were directed to the originally presented - that is at issue.

Even more importantly, MPEP 811.02 and 811 clearly indicate that Examiner can require election whenever the need develops. As indicated previously, the amendment places an undue burden on the Office – the need has developed. As Examiner understands the rationale behind Office policy as it presently relates to this application: The Office determined the original species is not patentable, so applicant choose to present claims to a new invention – the new species. The Office has the resources to examine only one invention per application (fee-submission) unless, of course, there is no serious burden on the Office.

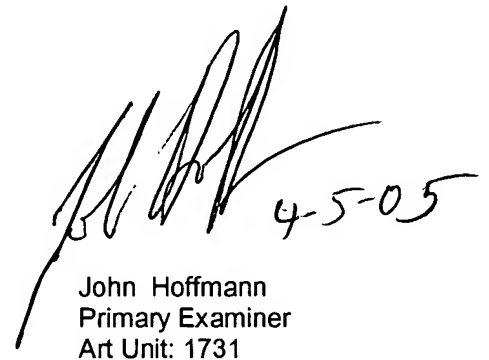
Furthermore, no burden is actually needed for the present application. Under the Patent Cooperation Treaty, the PTO is under no burden to show (or even allege) undue/reasonable burden. Under the PCT, there only be a lack of unity of invention. Since the Office has demonstrated that there is no invention in the claims as originally presented, there is no unity of invention. The Office has the right to require an additional application + fees for the examination of any newly presented specie – irrespective of any burden.

It is further argued that Fiorilla already examined the specie in question. Examiner does not understand the basis for this conclusion. If it is Applicant's position that Fiorilla's objection constitutes an examination, such is not convincing. Fiorilla merely

concluded that claim 17 requires two incompatible things. The objection does not constitute an examination. Most importantly, it does not suggest Fiorilla searched the prior art for the specie.

It is further argued that the action of January 3, 2005 complied with all the requirements of the June 28 Office action. This is largely irrelevant. The Office communication of 2/28/05 essentially has only a new requirement: present at least one claim that encompasses the constructively elected specie. It does not suggest Applicant failed to comply with any requirement from June.

Again Applicant is referred to MPEP 811, 811.02 and 821.03; they leave little doubt that the determination that Applicant's amendment was non-responsive was proper.



4-5-05

John Hoffmann
Primary Examiner
Art Unit: 1731